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09/597,318	06/19/2000	Frank Venegas JR.	IDS-10505/14	4057

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EXAMINER

YIP, WINNIE S

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/597,318

Applicant(s)

VENEGAS, FRANK

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on September 20, 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This office action is in response to applicant's amendment filed on March 2, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 20, 2002 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the cover alternatively having a flattened closed end.

#### *Specification*

2. The amendment filed September 20, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a description to the new Fig. 11, on pages 3 and 8, which introduce a new alternative embodiment shows the cover having a flatten closed end.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### *Claim Objections*

3. Claims 4-6 are objected to because of the following informalities:

In claims 4-6, the recited sub combination feature "said cavity **adapted to receive** the stanchion in slip fit engagement" does not positively recite the relationship between the

structural elements. It does not appear to consist with the limitation of the body of the claim because applicant recites an assembly with a stanchion and a sleeve. If applicant claims a combination (not a "kit claim"), all elements must be positively recited. For example, above phrase should read "said stanchion being received into said cavity in slip fit engagement". or "said cavity receiving said stanchion in slip fit engagement". Appropriate correction is required.

Due to the confusion, the claims 4-6 are being treated as a combination "kit claim" on the merits.

4. Claim 5 is also objected to because of the following informalities: the claimed language "nothing else is required to retain said cover on said stanchion" (line 10) merely recites a negative structural limitation to the body of claim because applicant only recites the assembly "comprising" but not "consisting" elements. Whether or not other additional elements applied to the claimed invention is not part of the claimed invention. Therefore, this limitation is given very little patentable weight.

#### ***Double Patenting***

5. Claims 1-7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4-5, 14, and 17 of U. S. Patent No. 5,323,583. Although the conflicting claims are not identical, they are not patentably distinct of the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as

follows: a cover consisting of a sleeve having an elongated body having an enclosed hemispherical top with an interior cavity to be slip fitted on a stanchion.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See also MPEP 804.

***Claim Rejections - 35 U.S.C. 102***

6. Claims 2-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Deike (US patent No. 4,021,977).

Deike shows and teaches a stanchion and cover assembly comprising a substantially rigid elongated stanchion (12) having a lower end being secured to a fixed anchor (11) which is fixed into the ground and a upper terminal end extending over the ground, a sleeve (13) made of plastic and having an elongated, generally cylindrical body extending between two opposing ends, the sleeve having a generally cylindrical interior cavity and having substantially the same wall thickness, the opposing ends including an opened lower end to receive the elongated stanchion (12), and a closed second end with a closed hemispherical shaped cap (13a), a reflector tape (15) being wrapped around the upper end portion of the sleeve, the sleeve (13) having a length slightly longer than the height of the upper portion of the stanchion (12), and the interior cavity having a cross-sectional shape being capable to be slip fitted in an engagement with the upper portion of the elongated stanchion (12) without other support elements such as a clamp.

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7. Claims 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Voegeli (US patent No. 3,812,279).

Voegeli shows and discloses a cover (12) capably used for a substantially rigid elongated cylindrical stanchion (21) having a lower end associated with the ground, the cover consisting essentially of: a sleeve (12) being made of a plastic and having an elongated, generally cylindrical body extending between two opposing ends, the sleeve (12) having a generally cylindrical interior cavity, the opposing ends including a closed first upper end having a closed hemispherical shaped dome top and an opened second lower end (25) capably for receiving a vertical stanchion in a slip-fit engagement, the sleeve (12) said sleeve having a wall of thickness and the thickness of the dome top being substantially the same, and said sleeve having a length capably slightly longer than a high of the upper portion of a stanchion (notice the stanchion is not claimed).

8. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Beatty (US patent No. 4,516,756).

Beatty, see Fig. 3, shows a cover (18) capably used for a substantially rigid elongated cylindrical stanchion (20) which has a lower portion associated with the ground and an opposing upper portion, the cover consisting essentially of: a sleeve (18) being made of a plastic, said sleeve (18) having an elongated, generally cylindrical body extending between two opposing ends, said sleeve (18) having a generally cylindrical interior cavity extending along the sleeve and through one of the two opposing ends, the interior cavity having a substantially consistent circular cross-sectional shape extending between the two opposing ends without any inwardly

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extending protrusion, the opposing ends including a closed top end transverse to the body and an opened lower end capably for receiving the vertical stanchion in a slip-fit engagement, the sleeve (12) having a wall of thickness and the thickness of the closed top end being substantially the same, and said sleeve having a length capably slightly longer than a high of the upper portion of a stanchion (notice the stanchion is not claimed) .

9. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Almond (US patent No. 4,972,864).

Almond shows a cover (25) capably used for a substantially rigid elongated cylindrical stanchion (12) which has a lower portion associated with the ground and an opposing upper portion, the cover consisting essentially of: a sleeve (15) being made of a plastic, said sleeve (25) having an elongated, generally cylindrical body extending between two opposing ends (28, 26) , said sleeve (25) having a generally cylindrical interior cavity extending along the sleeve and through one of the two opposing ends, the interior cavity having a substantially consistent circular cross-sectional shape extending between the two opposing ends without any inwardly extending protrusion, the opposing ends including a closed top end (28) transverse to the body and an opened lower end (26) capably for receiving the vertical stanchion (12) in a slip-fit engagement, the sleeve (25) having a wall of thickness and the thickness of the closed top end being substantially the same, and the sleeve having a length capably slightly longer than a high of the upper portion of a stanchion (notice the stanchion is not claimed) .

***Claim Rejections - 35 U.S.C. 103***

10. Claims 1-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Beatty '756 in view of Arth, Jr. '883.

Beatty shows and discloses a stanchion and cover assembly comprising a substantially rigid elongated stanchion (12) having a first end being secured the ground and a second end extending over the ground, the rigid elongated stanchion (12) may have a generally cylindrical shaped (see Fig. 3), a sleeve (18) having a generally cylindrical elongated body having an opened end and a opposing closed end, and a generally cylindrical interior cavity extending between the two opposing ends, and the sleeve and the closed end of the sleeve being molded from a plastic material and having substantially the same wall thickness, wherein the interior cavity of the sleeve (18) has a cross-sectional shape being elastically slip fitted in an engagement with the upper portion of the stanchion (see col. 2, line 19), said the sleeve forming a cover being retained over on the stanchion without any additional structural element.

Although Beatty does not define the closed end of the sleeve having a generally hemispherical shaped dome top as claimed, Beatty teaches the closed end of the sleeve may be formed in variety of shapes corresponding to the shape of the stanchion to be received therein (see Figs. 1 and 3). Further, Arth, Jr. teaches a protective cover (18) for covering an elongated stanchion (16), the cover having, as well known in the art, a closed, hemispherical shaped dome top (20) with a same shaped internal surface for increasing durability of the cover with a smooth outer surface (see col. 3, lines 43-45 and 49-51) for covering an elongated stanchion (16). Therefore,



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it would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time the invention was made, to modify the cover of Beatty to obtain an enclosed hemispherical top end as taught by Arth, Jr. as specified in claims 1-6 because Applicant has not disclosed that a cover having an closed top end being formed with a hemispherical shaped dome top end provides an advantage, is used for a particular purpose, or solves a stated problem.

Applicant further disclosed that the enclosed top end of the cover would be formed with various shapes such as show in Figs. 10A to 10B. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the either an enclosed flatten top end of Beatty or hemispherical shaped dome top as taught by Arth, Jr. because both shaped top ends perform the same function of providing a smooth protective cover with durable top end to accommodate the shape of the stanchion for protecting a penetration of the stanchion through the sleeve with desirable aesthetic appearance.

### ***Response to Amendment***

11. In response to applicant's argument that Deike '977 could not be possible anticipate the claims because the preamble of claim 1 includes the language "consisting essentially", we agree so, therefore the rejection to claim 1 as being anticipated by Deike '977 is withdraw. However, claims 2-3, 5, and 7 claim the invention "comprising" elements that appear stand read on the claimed invention. So, these claims stand rejected by Deike as discussed above rejections.

In response to applicant's argument that Voegeli '297 also could not be possible anticipate the claims 3 and 7 because the preamble of claim 1 includes the language "consisting essentially" without any explanation, it is not persuasive because claim 1 is not rejected by Voegeli.

In response to applicant's argument that there is no suggestion to combine the references Beatty in view of Arth, Jr., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). we agree that Beatty does not show the covers and stanchion having a top end with a hemispherical shape, otherwise the rejection will be under 35 USC 102 status. In this case, the references to Beatty, and Arth, Jr. teaches an assembly comprising a cover receiving a stanchion as claimed except that the top end of the cover. As applicant described in the specification, the cover may be formed with alternative embodiment with the top end can be formed in variety of shapes as shown in Figs. 6-9, 10A and 10B, Beatty discloses an assembly comprising a sleeve and a stanchion having top ends being accommodate with each other with various alternative shapes. Although Beatty does not show the various shape including a hemispherical shape. Arth, Jr. is used as a teaching reference to teach the cover would have been modified with other shaped top end such as a hemispherical top as claimed. Since applicant has not disclosed that a cover having an closed top end being formed with a hemispherical shaped dome top end provides an advantage, is used for a particular purpose, or solves a stated problem, One of ordinary skill in the art, would have expected applicant's invention to perform equally well with the either an enclosed flatten top end of Beatty or hemispherical shaped dome top as taught by Arth, Jr. as an obvious matter of design choice to

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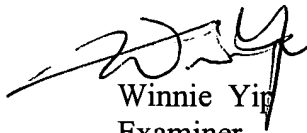
accommodate the shape of the stanchion to be used for protecting a penetration of the stanchion through the sleeve and having desirable aesthetic appearance.

Therefore, the rejection still granted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Winnie Yip  
Examiner  
Art Unit 3637

wsy  
May 19, 2003